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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 09/585,669
Filing Date: June 01, 2000
Appellant(s): MORAN, THOMAS

William M. Lee, Jr.
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 12 September 2007 appealing from the Office action mailed 30 May 2007.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

6,404,873 B1	BEYDA ET AL.	6-2002
6,757,259	HAMILTON	6-2004
5,812,865	THEIMER ET AL.	9-1998

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claims 35-51, 58, and 60-65 rejected under 35 U.S.C. 103(a) as being unpatentable over Beyda et al. (US 6,404,873 B1), hereinafter referred to as Beyda.

Claims 52-55, 57, and 59 are rejected under 35 U.S.C. 103(a) as being unpatentable over Beyda (US 6,404,873 B1) in view of Hamilton (US 6,757,259 B1).

Claim 56 is rejected under 35 U.S.C. 103(a) as being unpatentable over Beyda (US 6,404,873 B1) in view of Hamilton (US 6,757,259 B1) further in view of Theimer et al. (US 5,812,865), hereinafter referred to as Theimer.

This rejection is set forth in a prior Office Action, filed 12 September 2007, and is included below for the Board's convenience.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 35-51, 58, and 60-65 rejected under 35 U.S.C. 103(a) as being unpatentable over Beyda et al. (US 6,404,873 B1), hereinafter referred to as Beyda.

Regarding claims 35, 51, 60, and 62, Beyda discloses subconference calling, which comprises:

Forming a main conference between a plurality of users (Managing subconference calls within a main conference. See Abstract;)

Presenting at least one of said users in the main conference with a list of the main conference participants (Referring to Figures 1 and 2, the list of users is presented to a user in order for them to determine an appropriate subconference participant. See column 5, lines 31-41;)

Providing said user with an interface to interact with said list of main conference participants, such that said user has an option to request a subconference with a subset of other users by selecting subconference participants from said list using said interface (Referring to Figure 1, first terminal 14 transmits a subconference call request 28 to the sixth terminal 24, based upon the known list of participants. See column 4, lines 33-40;)

Forming a subconference between the user and the subset of other users (The subconference call subsystem 30 establishes a first subconference call. See column 4, lines 52-54;)

Maintaining private from the main conference at least some communication between the subset of users in the subconference during the subsistence of the subconference (Referring to Figure 2, data router 36 transmits voice data generated from the first terminal 14 and sixth terminal 24 over the first subconference call but not over the main conference call. See column 4, lines 66-67 and column 5, lines 1-3.)

Presenting to said user a graphical list of the subset of users in the subconference, when the subconference is in progress (Referring to Figures 1 and 2, the list of the subset of users in the subconference is presented during the text messaging between the initiator and the intended

recipient during the subconference between the first terminal **14** and the sixth terminal **24**. See column 4, lines 66-67 and column 5, lines 1-3.)

Beyda does not disclose *presenting at least one of said users in the main conference with a graphical list of the main conference participants.*

Although Beyda does not explicitly disclose “presenting a graphical list of the main conference participants to a user,” Beyda does teaches that traditional conference management systems comprise a coordinator computer terminal which displays the names and telephone numbers of all parties in the call (See column 1, lines 66-67 to column 2, lines 1-2.)

It would have been obvious to one of ordinary skill in the art at the time of the invention to implement a “graphical list of the main conference participants” in the system of Beyda. One of ordinary skill in the art would have been motivated to do so in order to provide a straightforward and efficient means to allow a main conference participant to request another party to engage in a subconference call as taught by Beyda (See column 2, lines 9-14.)

Regarding claim 36, the primary reference further teaches *wherein those users in the subconference are entirely isolated from participation in the main conference during the subsistence of the subconference* (Referring to Figure 2, data router **36** transmits voice data generated from the first terminal **14** and sixth terminal **24** over the first subconference call but not over the main conference call. See column 4, lines 66-67 and column 5, lines 1-3.)

Regarding claim 37, the primary reference further teaches *wherein the users in the subconference are prevented from contributing to the main conference but are able to monitor communications in the main conference during the subsistence of the subconference* (Voice data generated from first terminal **14** and sixth terminal **24** are transmitted only to participants in the

subconference call and voice data from the main conference call is transmitted to all terminals.

See column 4, lines 57-62.)

Regarding claims 38 and 61, the primary reference further teaches *wherein the main conference utilizes a plurality of media types, users in the subconference utilize one or more of said media types, and users in the subconference can actively or passively participate in the main conference in at least one media type during the subsistence of the subconference* (Users in the subconference can utilize video, audio, and whiteboard data from the main conference call.

See column 5, lines 22-26.)

Regarding claim 39, the primary reference further teaches *wherein the users utilize a plurality of media types in the main conference and/or subconference, said media types being selected from the group consisting of vide, audio and data signals* (Users in the subconference can utilize video, audio, and whiteboard data from the main conference call. See column 5, lines 22-26.)

Regarding claim 40, the primary reference further teaches *wherein the media types utilized in the main conference include video and audio, and wherein the subconference utilizes audio signals* (Users in the subconference can utilize video, audio, and whiteboard data from the main conference call. See column 5, lines 22-26.)

Regarding claim 41, the primary reference further teaches *wherein the media types utilized in the main conference include audio and data, and wherein the subconference utilizes data signals* (Users in the subconference can utilize video, audio, and whiteboard data from the main conference call. See column 5, lines 22-26.)

Regarding claims 42 and 58 as explained in the rejection statement of claims 35 and 51, Beyda discloses all of the claim limitations of claims 35 and 51 (parent claim).

Beyda does not disclose *wherein the users in the main conference are presented with said subconference list during the subsistence of the subconference.*

Beyda teaches that when a coordinator drops parties from the conference call to establish a subconference call, the other coordinators in the call are able to detect that some parties have been dropped (See column 2, lines 2-5.)

It would have been an obvious choice in design to one of ordinary skill in the art at the time the invention was made to allow users in the main conference to see the list of subconference users. One of ordinary skill in the art at the time the invention was made would have been motivated to do so in order for users to establish subconferences with any user present in the conferencing system.

Regarding claim 43, Beyda disclose *wherein the users in the main conference are not presented with said subconference list during the subsistence of the subconference* (Referring to Figures 2, 3, and 6, the subconference subsystem prevents any second voice data 38 from the first subconference call from being transmitted over the main conference call. See column 6, lines 61-63. And, the subconference call subsystem 30 establishes the call in a manner that is transparent to the other terminals in the main conference call. See column 4, lines 54-57.))

Regarding claim 44, the primary reference further teaches *wherein the main conference is formed on a conference bridge to which each of the main conference users is connected* (The main conference is routed a data router 36, or by a switch, hub, or bridge where the IP telephony terminals are connected. See column 4, lines 20-26.)

Regarding claim 45, the primary reference further teaches *wherein the subconference users remain connected to the bridge and the subconference is formed by creating a second conference on the bridge simultaneously with the main conference* (The subconference call subsystem 30 establishes the call in a manner that is transparent to the other terminals 16, 18, 20, and 22 in the main conference call, which inherently resides on the same data router 36. See column 4, lines 54-57.)

Regarding claim 46, the primary reference further teaches *wherein the user(s) to whom the request is addressed have the option of accepting or refusing to join the subconference, and wherein such acceptance or rejection determines whether or not they remain as part of said subset* (After transmitting the request to the sixth terminal 24, the subconference call subsystem 30 monitors for an acceptance to the call set-up request which can be accepted or rejected, which inherently determines whether the sixth terminal 24 forms a subconference with the first terminal 14. See column 4, lines 50-52.)

Regarding claim 47, the primary reference further teaches *wherein each user in the subconference is provided with the option to leave the subconference at any time during the subsistence of the subconference* (Referring to Figure 5, when a subconference call is established, at any time during the subconference call, any terminal participating in the subconference call can transfer to bi-directional transmission within the main conference call. See column 6, lines 27-30.)

Regarding claim 48, the primary reference further teaches *wherein users opting to leave the subconference are automatically returned to full participation in the main conference* (Any

terminal that can transfer among each of its subconference calls and the main conference call.

See column 6, lines 30-34.)

Regarding claim 49, the primary reference further teaches *wherein users in the subconference are presented with the option of requesting one or more of the other subconference users to join a nested subconference within said initial subconference* (Referring to Figures 3, 4, 5, and 7, the subconference subsystem **30** monitor the main conference call and the first subconference call for a second request to establish a second subconference call. See column 7, lines 6-10.)

Regarding claim 50, the primary reference further teaches *wherein users in the subconference are presented with the option of requesting one or more of the other subconference users to leave said initial subconference and from a new subconference without rejoining the main conference* (Referring to Figure 5, the fourth terminal **20** can establish a second subconference call from either the first subconference call or the main conference call. See column 6, lines 14-16.)

Regarding claim 63, the primary reference further teaches *means for enabling the user to select one or more media types for use during said subconference* (Users in the subconference can utilize video, audio, and whiteboard data from the main conference call. See column 5, lines 22-26.)

Regarding claim 64, the primary reference further teaches *when embodied in a multimedia terminal for use in a conference* (Referring to Figure 2, multimedia terminals **14** and **24**.)

Regarding claim 65, the primary reference further teaches *when embodied in the form of a telephone handset having a graphical display for presentation of said graphical list and input means for operation of said interface* (Referring to Figure 2, multimedia terminals 14 and 24.)

Claims 52-55, 57, and 59 are rejected under 35 U.S.C. 103(a) as being unpatentable over Beyda (US 6,404,873 B1) in view of Hamilton (US 6,757,259 B1).

Regarding claim 52 as explained in the rejection statement of claim 51, Beyda discloses all of the claim limitations of claim 51 (parent claim).

Beyda does not disclose *wherein the main conference list memory unit and the subconference list memory unit are logical areas within a single memory unit.*

Hamilton teaches a conference bridge comprising all memory within a central unit (See Figure 1.)

It would have been obvious to one of ordinary skill in the art at the time the invention was made to implement the memory units as a single memory unit of Hamilton in the subconferencing system of Beyda. One of ordinary skill in the art at the time of the invention would have been motivated to do so in order to simplify system design, reduce system costs, and improve efficiency.

Regarding claim 53 as explained in the rejection statement of claim 51, Beyda discloses all of the claim limitations of claim 51 (parent claim).

Beyda does not disclose *wherein the functions of the main signal processing means and of the subconference signal processing means are carried out by the same signal processing unit.*

Hamilton teaches a conference bridge comprising all signal processing within a central unit (See Figure 1.)

It would have been obvious to one of ordinary skill in the art at the time the invention was made to implement the signal processing as a single signal processing unit of Hamilton in the subconferencing system of Beyda. One of ordinary skill in the art at the time of the invention would have been motivated to do so in order to simplify system design, reduce system costs, and improve efficiency.

Regarding claim 54, the primary reference further teaches *wherein said signal processing unit is adapted to combine signals of different media types* (Users in the subconference can utilize video, audio, and whiteboard data from the main conference call. See column 5, lines 22-26.)

Regarding claim 55, the primary reference further teaches *wherein said media types are selected from video, audio and data* (Users in the subconference can utilize video, audio, and whiteboard data from the main conference call. See column 5, lines 22-26.)

Regarding claim 57, the primary reference further teaches *wherein said main control unit includes means for forwarding said list of users in the conference to each of the users* (Referring to Figure 1, first terminal 14 transmits a subconference call request 28 to the sixth terminal 24, based upon the inherently known list of participants. See column 4, lines 33-40.)

Regarding claim 59, the primary reference further teaches *a conferencing server connected to the conferencing server, and means for connecting users to the call server* (Managing subconference calls within a main conference. See Abstract.)

Claim 56 is rejected under 35 U.S.C. 103(a) as being unpatentable over Beyda (US 6,404,873 B1) in view of Hamilton (US 6,757,259 B1) further in view of Theimer et al. (US 5,812,865), hereinafter referred to as Theimer.

Regarding claim 56 as explained in the rejection statement of claim 51, Beyda discloses all of the claim limitations of claim 51 (parent claim).

Beyda does not disclose the *subconference control unit being dynamically programmable causing said subconference signal processing means to generate outgoing signal streams containing a user selected combination of media types selected from the incoming signals for the users subconference.*

Theimer selectively establishing communications paths between media devices based on the context of the users. For example, user_A may set up an electronic conference with user_B. User_A may specify that a video connection is preferred, and user_A may also accept telephone, or voice only, connection (See column 27, lines 33-46.)

It would have been obvious to one of ordinary skill in the art at the time the invention was made to implement the selective communications path method of Theimer in the system of Beyda. One of ordinary skill in the art would have been motivated to do so in order to provide a system which allows users to select media data paths between users to tailor conferences to a user's capabilities as taught by Theimer (See column 4, lines 10-13.)

(10) Response to Argument

Issue I

On page 11 of the brief, regarding claims 35, 51, 60 and 62, the Appellant argues Beyda does not disclose *presenting at least one of said users in the main conference with a graphical list of main conference participants*. The Examiner respectfully agrees. The Examiner concedes that Beyda does not disclose "presenting at least one of said users in the main conference with a **graphical list** [emphasis added] of main conference participants." However, Beyda implies a "list" (not necessarily graphical, as it may be virtual, auditory, physical or otherwise) of users is presented to a user in order for them to determine an appropriate subconference participant (See column 5, lines 31-41.) The Examiner provides the following reasoning. Beyda teaches that the advances in telecommunications have made available teleconferencing features that more closely approximate a face-to-face meeting for individuals who are located at substantial distances from each other (See column 1, lines 11-23.) Beyda further teaches that one needs a system and a method for transparently establishing subconference calls during a conference call in a manner which enables the subconference call parties to receive voice information from the conference during the subconference (See column 2, lines 9-10,) which is an improvement upon the system of Bales which utilizes a display. In addition, Beyda discloses that the telephony conference call is established utilizing convention IP telephony methods in which users may request a subconference call, these systems utilize either a traditional auditory or visual list (See column 2, lines 26-40.) Therefore, the utilization of a list is implied for the establishment of a conference and subconference call.

Beyda's system and method are an improvement upon the traditional prior art systems, as described in column 1, line 37 to column 2, line 5. In order for traditional systems to permit a user to select another user for a subconference one must ascertain knowledge of the participants

in a main conference. Whether a "list" is gained via listening to a reading of participants' identification, as referenced to Eaton 5,483,588 by Beyda in column 11, lines 16-35, or presented to the users via a virtual or physical manifestation, users must glean some knowledge of main conference participants regardless of form of the "list." Again, it is the Examiner's position that Beyda presents the user with a "list," but is silent to the whether the "list" is graphical or not (it could be, but may not necessarily be so). Beyda does not explicitly disclose *presenting at least one of said users in the main conference with a **graphical list** of the main conference participants*. However, Beyda teaches traditional prior art conference management systems in which a coordinator computer terminal displays the names and telephone numbers of all parties in the call (graphical list) (See column 1, lines 66-67 to column 2, lines 1-2.) It would have been obvious to one of ordinary skill in the art at the time of the invention to implement a "**graphical list of the main conference participants**" in the system of Beyda. One of ordinary skill in the art would have been motivated to do so in order to provide a straightforward and efficient means to allow a main conference participant to request another party to engage in a subconference call as taught by Beyda (See column 2, lines 9-14.)

Issue II

On page 14 of the brief, regarding claims 35, 51, 60 and 62, the Appellant argues Beyda does not disclose *providing said user with an interface to interact with said graphical list of main conference participants, such that said user has an option to request a subconference with a subset of other users by selecting subconference participants from said graphical list using said interface*. The Examiner respectfully agrees. The Examiner concedes that Beyda does not

disclose "providing said user with an interface to interact with a **graphical list** ... to select subconference participants from said **graphical list** using said interface." Beyda discloses a first terminal **14** transmits a subconference call request **28** to the sixth terminal **24**, based upon the known list of participants (See column 4, lines 33-40.) For the same reasons stated above Beyda presents users with a "list" of participants, but Beyda is silent to whether the "list" is graphical or not. The claimed invention combines the well-known subconferencing system of Beyda with a well-known graphical user interface as taught in the prior art section of Beyda. To modify the system of Beyda to utilize a graphical user interface, which meets the claimed limitations, is obvious for the reasons set forth above.

Issue III

On page 15 of the brief, regarding claims 25, 51, 60 and 62, the Appellant argues Beyda does not disclose *the list of the subset of users in the subconference is present during the text messaging between the initiator and the intended recipient during the subconference*. The Examiner respectfully disagrees. Beyda discloses the list of the subset of users in the subconference is presented during the text messaging between the initiator and the intended recipient during the subconference between the first terminal **14** and the sixth terminal **24** as signified by the subconference request message (See column 4, lines 66-67 and column 5, lines 1-3.) The request to initiate a subconference represents a "subset" since it reflects both the initiator and the recipient of the subconference. Therefore, Beyda discloses *the list of the subset of users in the subconference is present during the text messaging between the initiator and the intended recipient during the subconference*.

Issue IV

On page 16 of the brief, regarding claim 36, the Appellant argues Beyda does not disclose *wherein those users in the subconference are entirely isolated from participation in the main conference during the subsistence of the subconference*. The Examiner respectfully disagrees. Beyda teaches a data router 36 that transmits voice data generated from the first terminal 14 and sixth terminal 24 over the first subconference call but not over the main conference call (See column 4, lines 66-67 and column 5, lines 1-3.) In this manner the subconference between users provides complete privacy from main conference participants' interference, and the subconference is "entirely isolated from participation in the main conference during the subsistence of the subconference." The Appellant argues for a specific interpretation of the claim, irrespective, the Examiner interprets the claim in a broad literal reasonable fashion which is different from the Appellant.

Issue V

On page 16 of the brief, regarding claims 42 and 58, the Appellant argues Beyda does not teach or otherwise make obvious *wherein the users in the main conference are presented with said subconference list during the subsistence of the subconference*. The Examiner respectfully disagrees. Beyda teaches when a coordinator drops parties from the conference call to establish a subconference call, the other coordinators in the call are able to detect that some parties have been dropped (See column 2, lines 2-5.) It would have been an obvious choice in design to one of ordinary skill in the art at the time the invention was made to allow users in the main

conference to see the list of subconference users. One of ordinary skill in the art at the time the invention was made would have been motivated to do so in order for users to establish subconferences with any user present in the conferencing system using a graphical display as stated above regards to Issues I and II.

Issue VI

On page 17 of the brief, regarding claims 52-55, 57 and 59, the Appellant argues Beyda does not teach or otherwise make obvious each respective claim for the same reasons regarding claim 51. The Examiner respectfully disagrees for the same reasons stated above in regards to claim 51 (parent claim).

Issue VII

On page 17 of the brief, regarding claim 56, the Appellant argues Beyda does not teach or otherwise make obvious each respective claim for the same reasons regarding claim 51. The Examiner respectfully disagrees for the same reasons stated above in regards to claim 51 (parent claim).

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

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For the above reasons, it is believed that the rejections should be sustained.

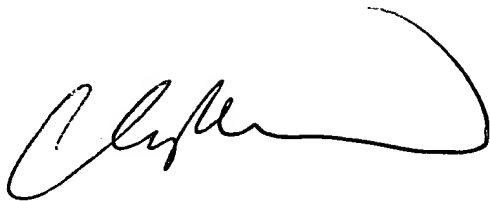
Respectfully submitted,

/Donald L Mills/

February 4, 2008

Conferees:

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SUPERVISORY PATENT EXAMINER 2/4/08

Wellington Chin